

### **REMARKS**

The Final Rejection of May 2, 2007, and the Advisory Action of July 6, 2007, have been carefully reviewed and this Request for Continued Examination under 37 C.F.R. § 1.114 addresses the Examiner's concerns stated in the Final Rejection and the Advisory Action. The amendment in response to the Final Rejection has been entered.

#### **I. REQUEST FOR CONTINUED EXAMINATION UNDER 37 C.F.R. § 1.114**

Applicants herein file a Request for Continued Examination under 37 C.F.R. § 1.114, along with authorization for payment of the filing fee for a large entity.

#### **II. STATUS OF THE CLAIMS**

Claims 1, 3-30 are pending in the application.

Claims 1, 3-27, and 29-30 have been amended to clarify terminology and further define the invention. In particular, independent claims 1, 6, 11, and 22, and dependent claims 3-5, 7-10, 12-21, 23-27, 29, and 30 have been amended to further define the invention. Dependent claims 9, 14, and 18 have been amended to clarify terminology.

With respect to independent claim 1, support for the amendments can be found in Applicants' Specification, paragraphs 21 and 24. No new matter has been added.

With respect to independent claims 6 and 11, and dependent claims 7, 12, 16, 17, 23, and 24, support for the amendments can be found in Applicants' Specification, paragraphs 11, 21, 24, 26, and 45. No new matter has been added.

With respect to independent claim 22, support for the amendments can be found in Applicants' Specification, paragraphs 7, 11, 21, 24, 26, and 45. No new matter has been added.

With respect to dependent claims 3 and 4, support for the amendments can be found in Applicants' Specification, paragraph 21. No new matter has been added.

With respect to dependent claim 5, 10, 15, and 24, support for the amendments can be found in Applicants' Specification, paragraphs 21 and 24. No new matter has been added.

With respect to dependent claims 8, 13, and 25, support for the amendments can be found in Applicants' Specification, paragraph 45. No new matter has been added.

With respect to dependent claims 9, 14, 18, 26, and 30, the amendment is for clarification of terminology. No new matter has been added.

With respect to dependent claims 19-21 and 27, support for the amendments can be found in Applicants' Specification, paragraph 25. No new matter has been added.

With respect to dependent claim 29, support for the amendments can be found in Applicants' Specification, paragraph 24. No new matter has been added.

Claim 30 was rejected under 35 U.S.C. § 112, first paragraph, in the Final Rejection. However, the Advisory Action stated the amendment in response to the Final Rejection was entered, and that this rejection was withdrawn.

Claims 6, 8-9, 11, 13-15, 18, and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ryan, Jr. et al., United States Patent # 7,071,437, issued on July 4, 2006, published on July 3, 2003, filed on December 31, 2001 (Ryan). Applicants respectfully point out that Ryan was published within a year of Applicants' filing date, October 30, 2003. Applicants reserve the right to swear behind Ryan.

Claims 1, 3, 5, 7, 10, 12, 22-26, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone, United States Patent Application # 2002/0141,613, published on October 3, 2002, filed on March 27, 2001 (Sansone).

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan as modified by Sansone, and in further view of Lopez, United States Patent Application # 2002/029,202, published on March 7, 2002, filed on December 13, 2000 (Lopez).

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield, United States Patent # 6,025,931, issued February 15, 2000 (Bloomfield).

Claims 19-21 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

### III. REJECTIONS UNDER 35 U.S.C. § 102

On pages 6-12, in paragraphs 7-8, the Office Action states that claims 6, 8-9, 11, 13-15, 18, and 28 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Ryan.

Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims.

Applicants have amended claims 6, 8-9, 11, 13-15, and 18. No new matter has been added.

It is submitted that, with respect to amended independent claims 6 and 11, Ryan does not anticipate Applicants' claimed computer readable code configured to cause at least one processor to compare mail piece image characteristics to the selected predetermined profile from the retrieved data, and identify the mail piece as requiring one of the plurality of actions identified by the action

identifier from the retrieved data, if the mail piece image characteristics present in the retrieved data substantially match the values for the selected predetermined profile from the retrieved data because Ryan simply concludes that a mailpiece is suspect if the mailpiece meets a particular percentage of the criteria stored in the suspect database (Ryan, col. 12, lines 22-24). This is not the same as Applicants' claimed profile including a plurality of selected profile image characteristics because in Ryan, the mailpiece is compared against all the criteria on each pass, without an apparent sorting of criteria into subsets, i.e. Applicants' profiles including selected characteristics. The effect is that the order of comparison of each individual criteria in Ryan, for example, alphabetical ordering, would determine the search time, whereas Applicants claim selected characteristics in each profile determines a comparison subset that can be more thoughtfully arranged to reduce search time. Ryan does not state or suggest that the criteria are members of profiles, nor that they have values, nor that the profiles are each associated with a plurality of actions. Instead, Ryan simply states that "The suspect database contains various criteria such as the criteria described above (under the heading SUSPECT/HARMFUL MAILPIECES) for determining a suspect mailpiece." (Ryan, col. 12, lines 15-18). Further, Ryan does not state an action identifier configured to specify a plurality of actions because Ryan simply compares an image with the contents of the suspect database and takes a single action.

With respect to claim 15, it is submitted that Ryan does not disclose Applicants' claimed selected combinations of profile image characteristics because Ryan's list of criteria is not selectively combined, but is a simple list.

It is submitted that dependent claims 8, 9, 13, 14, 18, and 28 are patentable at least by virtue of their selective direct or indirect dependence upon independent claims 6 and 11.

Since Ryan does not teach each and every element of Applicants' amended independent claims 6 and 11 and claims 8-9, 13-15, 18, and 28 which depend selectively therefrom, Applicants' amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are not anticipated by Ryan, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Further, it is submitted that amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28 are not made obvious by Ryan under 35 U.S.C. § 103. Applicants assert that amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are now in condition for allowance.

Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) with regards to amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, for the reasons set forth above.

#### IV. REJECTIONS UNDER 35 U.S.C. § 103

On pages 10-16, in paragraphs 10-11, the Office Action states that claims 1, 3, 5, 7, 10, 12, 22-26, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

In order for a rejection under 35 U.S.C. § 103 to be sustained, the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

It is submitted that amended independent claims 1 and 22 are not made obvious by Ryan in view of Sansone because (1) Ryan does not disclose Applicants' claimed steps of selecting a plurality of profile image characteristics for each one of the plurality of predetermined profiles and repeating steps (d) through (f) for another one of the plurality of predetermined profiles, if the predetermined profile does not substantially match the mail piece image characteristics, and (2) Sansone cannot make up this deficiency because neither does Sansone disclose Applicants' claimed steps as above. With respect to (1), Applicants agree with the Office Action that states that Ryan Jr. fails to specifically suggest repeating steps (c) through (e) (Final Rejection, page 11, paragraph 11) because Ryan performs a single comparison, and also because Ryan does not include the concept of profiles

as Applicants have claimed and described (Applicants' Specification, paragraph 24). With respect to (2), Sansone cannot make up the deficiency in Ryan because Sansone does not disclose or suggest Applicants' claimed repeating the step of retrieving another profile, because Sansone does not include Applicants' claimed profile that includes selected profile image characteristics. Sansone performs a sequential comparison, first against a threat criteria database, then against a sender database, then against a recipient database, and so on. Sansone's comparisons are defined and limited to the stated databases. Applicants, on the contrary, claim the step of comparing mail piece image characteristics with the plurality of predetermined *profiles* successively until a match, if any, is found. An exemplary profile having selected image characteristics is shown in Applicants' Specification, paragraph 24, and includes, for example, initiating P&DC, destination address, destination-address style (e.g. handwritten), return-address style (e.g. not present), POSTNET bar code (e.g. not present), and envelope length (e.g. 7 inches). Applicants' system is clearly different from, more flexible than, and not obvious from Sansone because Applicants can establish any combination of image characteristics in a profile, whereas Sansone is limited to a specific sequence of comparisons against a specific set of characteristics. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations.

It is submitted that amended dependent claim 3 is not obvious in view of Ryan and Sansone at least because of its dependence on allowable independent claim 1.

It is submitted that amended dependent claims 5, 10, and 24 are not obvious in view of Ryan and Sansone because neither Ryan nor Sansone discloses or suggests Applicants' claimed predetermine profiles that include selected combinations of profile image characteristics. Any comparisons that are done in Ryan and Sansone are against individual characteristics in isolation, but not in combination with each other.

It is submitted that amended dependent claims 7, 12, and 23 are not made obvious by Ryan in view of Sansone because neither Ryan nor Sansone states Applicants' claimed plurality of actions identified by an action identifier the retrieved data. As stated previously, Ryan does not state or suggest that the criteria are stored as profiles, nor that the criteria are data such as an identifier or an action identifier. In fact Ryan teaches away from such an interpretation because Ryan lists criteria (Ryan, col. 5, lines 20-65), and the list does not include an identifier or an action identifier. Sansone

cannot make up the deficiency in Ryan because not only does Sansone not state Applicants' claimed profiles that include data comprising an identifier, an image characteristic, and an action identifier, but Sansone states particular databases for particular characteristics such as threat characteristics, sender names, etc., and none of these databases is stated to contain anything but the particular characteristic. Thus Sansone neither states nor suggests Applicants' claimed database having an identifier or an action identifier where the database also includes image characteristics. In amended dependent claims 7, 12, and 23, Applicants' claim one of the plurality of actions identified by the action identifier that is part of the profile database claimed in independent claims 6, 11, and 22. Because neither Ryan nor Sansone states or suggests such a database, their combination cannot make out a *prima facie* case of obviousness.

It is submitted that dependent claims 25, 26, and 29 are not obvious in view of Ryan and Sansone at least because of their dependence on allowable independent claims 1 and 22.

It is submitted that step (m) of amended dependent claim 30 is not made obvious by Ryan and Sansone for the same reasons stated with respect to amended independent claims 1 and 22. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations of amended dependent claim 30. In particular, neither Ryan nor Sansone nor their combination teach or suggest Applicants' claimed repeatedly retrieving other profiles if the predetermined profile does not match the mail piece image characteristics.

On page 16, in paragraph 12, the Office Action states that dependent claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Lopez.

It is submitted that amended dependent claim 4 is not obvious in view of Ryan, Sansone, and Lopez for the same reasons stated with respect to amended independent claims 1 and 22, and amended dependent claim 30, namely because neither Ryan nor Lopez nor their combination discloses or suggests Applicants' claimed step of comparing a predetermined profile to mail piece image characteristics. As stated previously with respect to amended independent claims 1 and 22, Ryan and Sansone lack this step. Lopez does not make up the deficiency because Lopez performs certain steps on-line, and a different set of steps off-line, none of which steps include comparing a mail piece characteristics against the predetermined profile.

On pages 17-18, in paragraph 13, the Office Action states that dependent claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield.

It is submitted that amended dependent claims 16 and 17 are not obvious in view of Ryan and Bloomfield because neither Ryan nor Bloomfield nor their combination discloses or suggests Applicants' claimed remote server having computer readable code that identifies the mail piece as requiring one of the plurality of actions identified by the action identifier from the retrieved data. Ryan does not disclose Applicants' claimed remote server having computer readable code that includes an action identified by the action identifier from the retrieved data for the reasons stated previously with respect to amended dependent claims 7, 12, and 23. Bloomfield does not make up for Ryan's deficiency because Bloomfield simply forwards e-mail (Bloomfield, col. 7, lines 49-59) without reference to any sort of action identifier in a profile database.

On pages 18-19, in paragraph 14, the Office Action states that dependent claims 19-21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

It is submitted that amended dependent claims 19-21 and 27 are not obvious in view of Ryan and Sansone because neither Ryan nor Sansone discloses or suggests Applicants' claimed comparison of mail piece image characteristics with a subset of the plurality of the predetermined profiles simultaneously. Neither Ryan nor Sansone disclose or suggest simultaneous comparisons because any comparisons done in Ryan and Sansone are sequential.

Since none of Ryan, Sansone, Lopez, or Bloomfield, either individually or in combination, teach or suggest each and every element of Applicants' amended claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, Applicants' amended claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are not made obvious by Ryan, Sansone, Lopez, and Bloomfield, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to amended claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, for the reasons set forth above.



## VI. CONCLUSION

Amended independent claims 1, 6, 11, and 22 are believed to be in condition for allowance for the reasons provided herein. It is submitted that dependent claims 3-5, 7-10, 12-21, and 23-30 are also allowable for the reasons presented above, and further because they depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.


Although no additional fees are anticipated, the Commissioner for Patents is authorized to charge additional fees, or credit overpayment, to Deposit Account No. 03-2410, Order No. 12078-194.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,

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